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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,656	02/19/2004	Masahiko Murayama	030662-107	9022
21839	7590	07/14/2004	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P			CHOWDHURY, TARIFUR RASHID	
POST OFFICE BOX 1404				
ALEXANDRIA, VA 22313-1404			ART UNIT	PAPER NUMBER
			2871	

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/671,656	MURAYAMA ET AL.	
	Examiner	Art Unit	
	Tarifur R Chowdhury	2871	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/468,818.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>09/29/03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/468,818, filed on 12/22/1999. **Specification**
2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6, 8-12, 14

and 16-20 of copending Application No. 09/468,818. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are anticipated by the claims of the copending Application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, 5-7, 9, 10, 13-15 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al (hereinafter Mori), PN 5,805,253.

Mori discloses in column 20, lines 16-55, a liquid crystal display comprising:

- a liquid crystal cell PIC;

- polarizing plates A and B, arranged on both sides of the liquid crystal cell;
- optical compensatory sheets OC1 and OC2, arranged between the liquid crystal cell and the polarizing plates;

Mori further discloses in column 3, lines 54-66 that the optical compensatory sheet comprises a transparent support and an optically anisotropic layer provided thereon, the optically anisotropic layer comprising a compound having one or more discotic structure units in its molecule. The transparent support has an optic axis in the direction of the normal of the support, and satisfies the condition of:

$$20 \leq ((n_x + n_y)/2 - n_z) * d_2 \leq 400$$

in which n_x and n_y are main refractive indices within the film, n_z is a main refractive index in the thickness direction of the film, and d_2 is the thickness of the support.

Mori also discloses that a cellulose acetate film is used as a transparent support (col. 21, line 60).

Mori does not explicitly disclose that the retardation value of the support is measured by light of 550 nm. However, 550 nm is a known visible range. Further, even Mori measured the retardation value of the support under a different wavelength range, the retardation value would not change much meaning it would fall very close to the disclosed range. Therefore, since the range disclosed by Mori overlaps the claimed range, claims 1, 9 and 17 would have been obvious.

As to claims 2, 10 and 19, Mori discloses in column 10, lines 46-50 that the support has a retardation value defined by $|n_x - n_y| * d_2$ in the range of 0 to 200 nm,

which overlaps the claimed range. Accordingly claims 2 and 11 would have been obvious.

With respect to claims 5 and 13, it is common and known for cellulose acetate to have at least two atomic rings in an amount in between 0.3 to 20 weight parts based on 100 weight parts of the cellulose acetate and thus would have been obvious to avail a proven material.

As to claims 6 and 14, applicant is claiming a functional feature of the compound, which is inherent for a cellulose acetate film having at least two atomic rings in an amount in between 0.3 to 20 weight parts, based on 100 weight parts of the cellulose acetate.

Regarding claims 7 and 15, Mori discloses in column 21, line 60 that the cellulose acetate support has a thickness of $100\mu\text{m}$, which overlaps the claimed range.

As to claim 18, Mori also discloses that the optically anisotropic layer is arranged between the liquid crystal cell and the cellulose acetate support.

With respect to claim 20, Mori discloses in column 6, lines 25-30 that his invention is characterized by the use of optical compensatory sheet for the liquid crystal display having the bend orientation cell or HAN cell. Accordingly, claim 12 would have been obvious.

Claims 3, 4, 8, 11, 12, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori as applied to claims 1, 2, 5-7, 9, 10, 13-15 and 17-20 above in view of Yabe et al (hereinafter Yabe), PN 4,499,043.

Mori does not explicitly disclose the cellulose ester is cellulose acetate having an acetic acid content in the range of 55.0 to 58.0% or 58.0 to 62.5%. Mori also does not explicitly disclose that the cellulose ester support is formed by solvent casting method. However, Yabe discloses in column 1, lines 14-55 that, cellulose acetate, cellulose acetate butyrate, cellulose acetate propionate have been used as cellulose ester supports. Cellulose acetate usually has an acetic acid content of 56% or more (overlaps the claimed ranges). Yabe further discloses that the common and known method for forming the cellulose ester substrate, is solvent casting method. Therefore, as evidenced by Yabe, the limitation of claims 3, 4, 8, 11, 12 and 16 and 8 are common and known and thus would have been obvious.

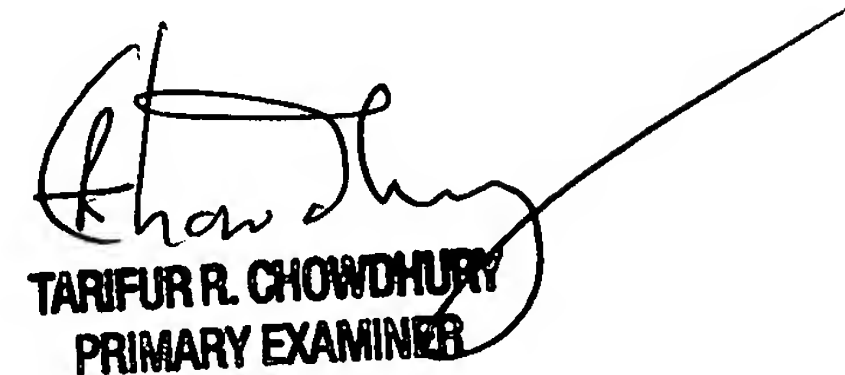
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tarifur R Chowdhury whose telephone number is (571) 272-2287. The examiner can normally be reached on M-Th (6:30-5:00) Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Kim can be reached on (571) 272-2293. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TRC
June 16, 2004


TARIFUR R. CHOWDHURY
PRIMARY EXAMINER